

REMARKS

I. Introduction

As an initial matter, applicants wish to thank Examiner Collins for the courtesies extended by her during a November 9, 2005, telephonic interview. The foregoing amendments and remarks below reflect the content of that interview.

Receipt of a final Office Action dated July 14, 2005, is acknowledged. In the action, claims 1, 2, 5, 7-22, and 27-29 were rejected for allegedly failing to comply with the written description requirement, and claims 1, 2, 5, 7-23, and 27-29 were rejected as allegedly lacking enablement. Claim 27 was also rejected as allegedly directed to non-statutory subject matter and claim 20 was objected to for formality reasons.

Applicants respectfully request reconsideration of the present application in view of the reasons that follow.

II. Status of the Claims

In this response, applicants amended claims 1, 2, 8, 9, 10, 12-14 and 20, cancelled claims 11 and 27-29, and added new claims 49-62. Exemplary support for the amended and new claims can be found throughout the specification, in Figure 1, and on page 2, line 22, Table 1 and page 27, lines 35 to 37 (claims 10, 12, 61, and 62), page 12, lines 1-5 (claims 1, 2, 49-60), page 26, lines 25-36, and page 27, lines 17-19 (claims 8, 9, 49, and 51-54). Upon entry of this amendment, claims 1-5, 7-10, 12-23 and 49-62 will be under examination.

Applicants reserve the right to file a divisional application directed to the subject matter of the withdrawn and/or cancelled claims.

It is acknowledged that this amendment is submitted after final rejection of the claims. However, because the foregoing amendments do not introduce new matter, and either place the application in condition for allowance or in better condition for appeal, entry thereof by the Examiner is respectfully requested.

III. Claim Objections

Claim 20 was rejected for reciting the acronym “POI.” Applicants amended claim 20 to refer to a “protein of interest” instead of “POI,” thereby rendering this rejection moot. Support for this amendment can be found on page 2, lines 20-22, of the specification.

IV. Rejection of the Claims Under 35 U.S.C. § 112

A. *Written Description Rejection*

Claims 1, 2, 5, 7-22, and 27-29 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. In particular, the claims were rejected because:

The description of a single isolated promoter polynucleotide obtained from the rice sucrose synthase 3 gene that comprises SEQ ID NO: 1, and twelve different truncations . . . is not representative of a genus that encompasses isolated promoter polynucleotides obtained from any unspecified source wherein the polynucleotides comprise a nucleotide sequence with at least 75% homology to SEQ ID NO: 1.

Office Action at 5. Also, claims 13-14 were further rejected because a nucleic acid sequence with at least 75% homology to a specific sequence “does not find support in the specification as filed and thus constitutes new matter.” Office Action at 4.

Without acquiescing to the Office’s rejection, and in the interest of expediting prosecution, applicants amended claims 1, 13 and 14 to delete the recitation of sequences having a particular percentage homology to SEQ ID Nos. 1 and 5. Claim 1 was further amended to recite SEQ ID No. 6 (Box B according to figure 1) instead of SEQ ID No. 1. Presently pending claims require that the promoter sequence comprise at least SEQ ID No. 1.

Applicants also amended claims 8 and 9 to refer to a nucleotide sequence with at least 95% sequence homology to SEQ ID No. 2, and amended claims 10 and 12 to refer to a nucleotide sequence with at least 95% sequence homology to SEQ ID NOS: 7, 8, 9, 10, 11, 12, 14, 16, 18, 20 and 24, which are sequences not contained within SEQ ID NO. 6 of claim

1. Support for these amendments can be found on page 27, lines 17-19 and 35-37, of the specification.

B. *Enablement Rejection*

Claims 1, 2, 5, 7-23, and 27-29 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly lacking enablement. Specifically, the claims were rejected because “it is unpredictable whether variants of SEQ ID NO: 1 would function as a promoter, or as an endosperm-preferred promoter” and “the unpredictability of variant polynucleotides functioning as promoters . . . is due to the known physical properties of promoter polynucleotides.” Office Action at 8. Applicants respectfully traverse this ground of rejection.

As stated above, applicants amended claim 1 to refer to a promoter comprising SEQ ID No. 6 and not to homologues or variants of SEQ ID No. 6. Therefore, the present rejection is rendered moot. Applicants trust that these amendments address the Examiner’s concerns.

V. **Rejection of the Claims Under 35 U.S.C. § 101**

Claim 27 was rejected under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. In the interest of expediting prosecution, applicants cancelled claim 27, thereby rendering this rejection moot.

Therefore, for at least these reasons, the rejection of the pending claims should be withdrawn.

CONCLUSION

Reconsideration of the present application in view of the foregoing amendments and arguments is kindly requested.

It is respectfully urged that the present application is now in condition for allowance. Early notice to that effect is earnestly solicited.

Examiner Collins is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

By _____



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Date November 14, 2005

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